

## **Remarks**

In response to the Office Action mailed March 9, 2006 ("the 3/9/2006 Office Action"), claims 1-3, 6-9, 12-14, 17, 18, and 22 have been amended. No claims have been added or cancelled. Therefore, claims 1-25 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and the following comments, allowance of all the claims pending in the application is requested.

### ***Information Disclosure Statement***

The Examiner has refused to sign a copy of the PTO-1449 submitted with the IDS filed September 2, 2005. In doing so, the Examiner has alleged that the IDS was not properly signed. However, as evidenced by the email sent to the Examiner from Karen McClain of the Patents Electronic Business Center on June 6, 2006, the IDS was properly signed. A copy of this email is attached herewith as **APPENDIX A**. Accordingly, the Examiner is requested to consider the references included in the IDS filed September 2, 2005, and return a signed copy of the PTO-1449 submitted therewith.

### ***Claim Objections***

The Examiner has objected to claims 12, 17, 18, and 22 as allegedly being of an improper Markush form. Applicants traverse this rejection on the grounds that the Examiner has not pointed to a formal defect in these claims. Even if these claims were of a Markush form, claims in Markush form are not *per se* improper. However, solely in an effort to expedite prosecution, Applicants have amended claims 12, 17, 18, and 22 in an attempt to obviate this objection.

### ***Rejections Under 35 U.S.C. § 101***

Claims 1-25 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-patentable subject matter. The Examiner relies on *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874), and asserts that the "claims do not identify

a practical application that produces a useful, tangible and concrete result using the claimed methodology.” The 3/9/2006 Office Action, page 3. Applicants traverse this rejection as legally improper because claims 1-25 recite patentable subject matter.

The Examiner argues that “[s]imply, receiving and storing values, creating a product, processing code for calculating a metric value, developing a message regarding affinity values, affinity values based on metric values, metrics reflecting the value of content, adding metric values, ranking metric values, determine [sic] a predetermine [sic] scheme, link combinations, ranking raw metric values, enabling a user to set a predetermine [sic] scheme, automatically determining a predetermine [sic] scheme, public or private affinity values, sending value to mailboxes related to thresholds, enabling threshold represent [sic] abstract concepts and do not have specific results.” Applicants disagree at least because these types of method steps and results have long been held by the Court of Appeals for the Federal Circuit and the U.S. Supreme Court to constitute patentable subject matter under § 101. See, e.g., *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999); and *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). Accordingly, the rejection of claims 1-25 under § 101 is improper and should be withdrawn.

### ***Rejection Under 35 U.S.C. § 102***

Claims 1-5 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 4,744,028 to Karmarkar (“Karmarkar”). Applicants traverse this rejection at least on the grounds that Karmarkar does not disclose all of the features of the claimed invention. However, solely in an effort to expedite prosecution, some of the claims have been amended to further clarify various aspects of the claimed invention.

Claim 1 recites, *inter alia*, “an affinity calculator that calculates affinity values for the people with respect to the categories, wherein the affinity value of a given person with respect to a given category reflects a strength of a relationship of the given person

*to the given category, the affinity values being calculated based on (i) the document values, (ii) the fit values, and (iii) the document usage data.”* Karmarkar fails to disclose at least this feature of claim 1.

Instead, Karmarkar is apparently drawn to systems and methods for resource allocation among a plurality of resource users to optimize technological and industrial resource allocation. See Karmarkar, col. 1, lines 6-12. The process disclosed in Karmarkar for determining the per unit costs of various possible allocations of resources does not disclose calculating affinity values that represent reflect the strength of relationships between people and documents. For at least this reason, the rejection of claim 1 based on Karmarkar should be withdrawn.

Claim 2 recites, *inter alia*, “*calculating separate metric values for the different types of interactions between the one or more users and the document, wherein the metric value for a given type of interaction between the one or more users and the document is proportional to a product of the raw metric value that corresponds to the given different types of interactions between the one or more users and the document and the constant value that corresponds to the given different types of interactions between the one or more users and the document; and aggregating the metric values calculated for the different types of interactions between the one or more users and the document to calculate a document value of the document,*” among other things. Claim 3 recites similar subject matter, among other things. Karmarkar fails to disclose at least this feature of the claimed invention.

The Examiner asserts that calculating a metric value proportional to a raw metric value and a constant value is disclosed in Karmarkar at FIG. 4, element 167. See the 8/05/2005 Office Action. However, decision box 167 of Karmarkar appears to function to terminate a procedure when no significant improvement in the objective function is observed, or beginning another iteration if improvement is still being made. See Karmarkar at col. 7, lines 26-30. More particularly, element 167 of FIG. 4 discloses determining a ratio of iterate values to quantify the improvement in the object function. Even if the iterate values of Karmarkar were analogous to a raw metric value and a

constant metric value, a ratio of these values would not be proportional to the product of these values, as is recited in claims 2 and 3. Further, Karmarker does not disclose “*aggregating the metric values calculated for the different types of interactions between the one or more users and the document to calculate a document value of the document.*” For at least these reasons, the rejection of claims 2 and 3 based on Karmarker are improper and should be withdrawn.

Claim 4 recites, *inter alia*, “*a metrics affinity module that sends at least one message to a user mailbox associated with the user according to a predetermined setting, the at least one message regarding the calculated affinity values.*” Claim 5 includes similar subject matter, among other things.

The Examiner asserts that this feature is anticipated by element 167 of FIG. 4 in that based on the equation shown in FIG. 4, the process of FIG. 4 proceeds to element 168 or 169. See the 3/9/2006 Office Action at page 6. The Examiner alleges that an operator of the algorithm shown in FIG. 4 would constitute a user. However, even if such an operator were construed as a user, neither element 168 nor 169 (nor the corresponding portions of the specification of Karmarker) disclose notifying this fictional operator in anyway, much less sending a message to “*a user mailbox associated with the [operator] according to a predetermined setting.*” For at least this reason, the rejection of claims 4 and 5 based on Karmarker is improper and should be withdrawn.

### ***Claims 6-25***

Applicants note that the Examiner has failed to provide a rejection under 35 U.S.C. § 102 or 35 U.S.C. § 103 for claims 6-25. Accordingly, when the rejection of claims 6-25 under 35 U.S.C. § 101 is withdrawn, these claims these claims should be indicated as including allowable subject matter.

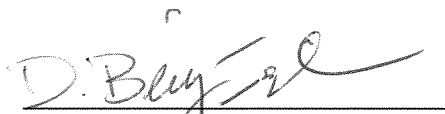
## **CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: June 9 2006

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "D. Benjamin Esplin", written over a horizontal line.

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